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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/761,987

01/21/2004

Joseph Broumand

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BRYAN W. BOCKHOP, ESQ.
BOCKHOP & ASSOCIATES, LLC
2375 MOSSY BRANCH DR.
SNELLVILLE, GA 30078

EXAMINER

AHMED, AFFAF

ART UNIT

PAPER NUMBER

3622

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/761,987	BROUMAND, JOSEPH	
	Examiner	Art Unit	
	AFAF AHMED	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 January 1967.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/01/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the application filed on 01/21/2004.
2. Claims 1-67 are currently pending and have been examined.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 2, 6, 10, 17, 21, 25, 32, 36, 39, 46, 50, 53, 62 and 66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claims 2, 17, 32, 46 and 58 recite the limitation of:
 - *a step of validating the user information from each of the plurality of the users. It is unclear what applicant is referring to by validating the user information from each of the plurality of the users. Appropriate correction and/ or clarification is required.*Claims 10, 25, 39, 53 and 66 recite the limitation of:
 - *if a user has opted to receive additional information from an advertiser, requesting personal information from the user and receiving the personal information from the use. It is unclear which user the applicant is referring to by if a user has opted to receive additional information from an advertiser, requesting personal information from the user and receiving the personal information from the use. Appropriate correction and/ or clarification is required.*Claims 6, 21, 36, 50 and 62 recite the limitation of:
 - *comprising the step of formatting the user information from each of the plurality of the users according to a predefined standard. It is unclear what applicant is referring to by formatting the user information from each of the plurality of the users according to a predefined standard. Appropriate correction and/ or clarification is required.*
6. Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should

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consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, 4, 7-10, 12-15, 17,19,22-25, 27-30, 32, 34, 37-39, 41-44, 46, 48, 51-58 and 63-66 are rejected under 35 U.S.C. 102(b) as being anticipated by Brierley et al US Pub No: US 2002/0161779 A1.

As per **claims 1, 12, 27, 41, 55, 56 and 57**, Brierley teaches:

- *receiving target information from an advertiser, the target information setting forth a set of criteria used to select a user from a plurality of users to receive a selected on-line promotion (see at least paragraphs 5, 24 and 43);*
- *displaying a web page to the plurality of users, the web page having a plurality of fields for collecting user information (see at least fig 3A,3B and 5B with associated text);*
- *receiving the user information from each of the plurality of the users (see at least paragraphs 24, 27 and 35);*
- *comparing the user information from each of the plurality of the users to the set of criteria (see at least paragraphs 29); and*
- *for each of the plurality of the users whose user information matches the set of criteria, displaying an on-line promotion from the advertiser in an opt-in window (see at least paragraphs 29, 43 and fig 8 B with associated text);*
- *a user data validation unit capable of validating information received from the user including information indicating that the user has opted into at least one on-line promotion; an electronic mail handler capable of sending a confirmation e-mail to a user that has opted to at least one on-line promotion (see at least paragraphs 38, 53 and fig 8B with associated text);*
- *generating pricing information to advertisers whose on-line promotions have been selected by at least one user, the pricing information being generated*

according to at least one objective factor indicative of a success level of the on-line promotions (see at least paragraphs 44, 55 and 56); and

- *a data storage unit capable of storing the set of advertiser criteria (see at least paragraphs 6 and 28).*

As per **claims 2, 17, 32, 46 and 58**, Brierley teaches:

- *validating the user information from each of the plurality of the users (see at least paragraphs 36, 38 and paragraph 39).*

As per **claims 4, 19, 34, 48 and 60**, Brierley teaches:

- *wherein the validating step includes the step of comparing the user's age against a predefined age range (see at least fig 3C with associated text).*

As per **claims 7, 22, 37, 51 and 63**, Brierley teaches:

- *receiving at least one selection from a user who has opted in for at least one selection from the opt-in window was displayed; and sending a confirmation e-mail to the user who has opted in at least one selection (see at least paragraphs 38, 53 and fig 8B with associated text).*

As per **claims 8, 23 and 64**, Brierley teaches:

- *sending to the advertiser the user information of the user who has opted in at least one selection (see at least paragraphs 8, 31 and 32).*

As per **claims 9, 24, 38, 52, and 65**, Brierley teaches:

- *using a portion of the user information to retrieve additional user data from a record; and assembling the additional user data into the user information (see at least paragraph 25).*

As per **claims 10, 25, 39, 53 and 66**, Brierley teaches:

- *if a user has opted to receive additional information from an advertiser, requesting personal information from the user and receiving the personal information from the user (see at least paragraph 41).*

As per **claims 13, 28 and 42**, Brierley teaches:

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- *wherein the at least one objective factor is a past performance indicator of a server hosting the web page (see at least paragraphs 31 and 56).*

As per **claims 14, 29 and 43**, Brierley teaches:

- *wherein the at least one objective factor is an opt-in rate for similar promotions (see at least paragraphs 31, 56, 57 and 79).*

As per **claims 15, 30 and 44**, Brierley teaches:

- *wherein the at least one objective factor is a confirmation e-mail open rate (see at least paragraphs 6, 38, 39, 68 and fig 12B with associated text).*

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 3, 5, 6, 16, 18, 20, 21, 31, 33, 35, 36, 45, 47, 49, 50, 59, 61, 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brierley et al US Pub No: US 2002/0161779 A1 in view of French et al, US Patent No: 6,282,658,B2.

Claims 3, 5, 18, 20, 33, 35, 47, 49, 59 and 61:

Brierley discloses the limitations as shown above.

Brierley does not disclose, but French, however, does disclose:

- *wherein the validating step includes the steps of checking a user address against a postal service database; and checking a user telephone number against a telephone service provider database (see at least column 7, lines 57-65 and column 10, lines 51-65);*
- *wherein the validating step includes the step of checking the user's e-mail address (see at least column 9, lines 27-28).*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Brierley's method and system of evaluating on-line promotion effectiveness with French's method and system of verifications of user's identity when conducting on-line transactions with the motivation of validating submitted user's information is correct.

Claims 6, 21, 36, 50, and 62:

Brierley discloses the limitations as shown above.

Brierley does not disclose, but French, however, does disclose:

- *comprising the step of formatting the user information from each of the plurality of the users according to a predefined standard (see at least column 10, lines 9-27).*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Brierley's method and system of for evaluating on-line promotion effectiveness with French's method and system of verifications of user's identity when conducting on-line transactions with the motivation with the motivation of providing a standard interface use by third party program such as a miler program, MS outlook program and bulk mail program.

11. Claims 16, 31 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brierley et al US Pub No: US 2002/0161779 A1 in view of Koningstein US Pub No: 2005/0096979.

Claims 16, 31 and 45:

Brierley discloses the limitations as shown above.

Brierley does not disclose, but Koningstein, however, does disclose:

- *wherein the at least one objective factor is a maximum bounty set by the advertiser (see at least paragraphs 81 and 82).*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Koningstein's method and system of enabling advertisement to follow the user to additional web page with the motivation of allowing advertisers to set up a maximum

budget through which advertisers are capable of providing effective and desirable advertisements to users.

12. Claims 11, 26, 40, 54 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brierley et al US Pub No: US 2002/0161779 A1 in view of OFFICIAL NOTICE.

Claims 11, 26, 40, 54 and 67:

Brierley discloses the limitations as shown above.

Brierley does not disclose:

- *using a portion of the user information to retrieve census data from a database; and assembling the census data into the user information.*

However, Examiner takes OFFICIAL NOTICE that it is old and well known and well known in marketing art to use census data for research, business marketing, planning purposes and sampling survey. It would have been obvious to one of ordinary skill in the art to modify Brierley's method and system of improving and evaluating on-line promotion with census data with the motivation of using the most accurate and available demographic data of population.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- Ferber, US Pat No: 7,184,971 B1 teaches method and apparatus for an e-mail affiliate program.
 - Anderson et al, US Pat No: 7,136,875 B2, teaches serving advertisements based on content.
 - Spitz et al, US Pat No: 7,162,221 teaches systems and methods for registering wireless devices users in marketing campaigns.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Affaf Ahmed whose telephone number is 571-270-1835. The examiner can normally be reached on Monday - Friday, 8:30 am-6:00 pm est, alt Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached at 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AA

/Yehdega Retta/

Primary Examiner, Art Unit 3622